

REMARKS

Claims 1-4 have been cancelled without prejudice or disclaimer. Claims 22-24 have been added. Support for claim 22 can be found in original claim 1 and throughout the specification, for example, from page 5, first paragraph, to page 6, fourth paragraph. Support for claim 23 can be found in original claims 2 and 3 and throughout the specification, for example, at page 6, last paragraph and at page 11, first paragraph. Support for claim 24 can be found in original claim 4 and throughout the specification, for example at page 6, third paragraph. Thus, this amendment is fully supported by the specification as originally filed and adds no new matter.

Rejection Under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 1-4 as allegedly being “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards at the invention.” Action at page 1. Although Applicants thank the Examiner for the suggested claim language and although Applicants do not acquiescence to the Examiner’s rejection, Applicants have cancelled claims 1-4 without prejudice or disclaimer. Thus, the Examiner’s rejection is moot. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 102

The Examiner rejected claims 1-4 under 35 U.S.C. § 102 allegedly being anticipated by US 6,337,196 to Kirchner et al. (Kirchner) or by the Patent Cooperation Treaty counterpart application to Kirchner (WO 98/30711). Action at page 2. Without acquiescing to the Examiner’s rejection, Applicants have cancelled claims 1-4 without prejudice or disclaimer. Consequently, the Examiner’s rejection of claims 1-4 under 35 U.S.C. § 102 is moot.

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Moreover, the rejection does not apply to new claims 22-24 because they are distinct from the teaching in both Kirchner references. Specifically, claim 22 recites the affirmative step of "dissolving prussic acid in an unsaturated organic solvent." In contrast, Kirchner recites the following method:

The enzyme immobilizate thus obtained was treated with 2.8 ml of ethyl acetate (saturated with 0.01 M sodium acetate buffer, pH 5.4) and with 141 mg of freshly distilled benzaldehyde (1.33 mmol). After the addition of 5.25 mmol of anhydrous hydrocyanic acid (200 μ l) the reaction vessel was sealed pressure-tight and the reaction mixture was stirred at room temperature for 1 hour.

Col. 4, lines 53-59. Thus, in Kirchner, the hydrocyanic acid (prussic acid) is anhydrous and, therefore, is not "dissolved in an unsaturated organic solvent" as recited in claim 22. For at least this reason, Kirchner cannot anticipate claim 22. Claims 23 and 24 depend from claim 22 and, thus, are likewise not anticipated by Kirchner.

Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 in view of Kirchner.

Applicants respectfully assert that the present application is in condition for allowance and request that the Examiner issue a timely Notice of Allowance for pending claims 22-24. If this papers does not put the claims in condition for allowance, the Applicants respectfully request that the Examiner contact the undersigned at (650) 849-6661.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

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Respectfully submitted,

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